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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,167	09/20/2001	Jeffrey L. Wrana	3477-91	3921

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EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,167

Applicant(s)

WRANA, JEFFREY L

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 3, 59, 10, 15, 19-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 2, 4, 6-8, 11-14 and 16-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Examiner of record has changed. Please address future correspondence to Examiner Michael Borin, AU 1631.

Claims pending are 1-44.

Response to restriction requirement filed 03/15/04 is acknowledged. Applicant elected, with traverse, Group I, claims 1,2,4,6,7,8,11-14,16-18. Applicant's traverse in regard to asserted lack of unity will be addressed in the first Office action on merits.

Further restriction

Upon further consideration of the claims of the elected group I, the following additional restriction of Group I was deemed necessary.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I.1. Claims 1,2,4,6-8,12-14,17,18-3 drawn to nucleotide sequence encoding mammalian SARA protein
- I.2. Claim 11, drawn to at least 10-base polynucleotide fragment of SEQ ID No. 1 or 3.
- I.3. Claim 12, drawn to polynucleotide sequence encoding at least one functional domain of SARA protein.

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The inventions listed as Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I.3 is the technical feature that links Groups I.1-I.3. Group I.2 is not the contribution over the prior art because it is suggested by references teaching at least 10-base polynucleotide fragment of SEQ ID No. 1 or 3. For example, such fragments are taught in Meckelein, B. et al (Identification of a novel serine protease-like molecule in human brain. *Molecular Brain Research* (1998), 55(2), 181-197). Further, a reference teaching polynucleotide sequence encoding at least one functional domain of SARA protein will not teach or suggest the multi-domain SARA protein itself, at least because similar domains are found in other proteins as well (see, e.g., Table 10).

Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

If Groups I.1 or I.2 are elected, the following election of species is hereby required:

Species Requirement

The claims of the Group are individually or dependently directed to a plurality of disclosed patentably distinct species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The claims of the Groups are individually or dependently directed to a plurality of disclosed patentably distinct species of peptides: peptides SEQ ID No. 2 and 4, or polynucleotides (SEQ ID No. 1 and 3) which have different structure and require separate

sequence search. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (571) 272-0722.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0549.

5/14/04

mlb

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

